

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket Number 135488CT (15163US01)

In the Application of:

Saad Ahmed Sirohey, et. al.

Serial No. 10/756,872

Filed: January 12, 2004

Title: System and Method For
Overlaying Color Cues on
A Virtual Representation
Of An Anatomical Structure

Examiner: Bernard Krasnic

Group Art Unit: 2624

**Electronically Filed on
December 30, 2008**

REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Paper responds to the Examiner's Answer mailed November 19, 2008. The Applicants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of claims 1-31 of the present application for at least the reasons discussed in the Appeal Brief and below.

The Examiner's Answer asserts a new ground of rejection. In particular, the Examiner's Answer rejects claims 1-8 and 17-23 under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. *See* Examiner's Answer at pages 3-5. The Examiner's Answer states that the "method steps of virtually dissecting the anatomical structure are not tied to another statutory category such as a particular apparatus (i.e. a processor for processing the specific method steps)." *See id.* at page 5. Thus, it appears that to the extent these claims may run afoul of 35 U.S.C. 101, the rejection is easily overcome by merely adding "using a processor/computer for performing the steps of" after "said method comprising" in each of claims 1 and 17.

It is clear, however, that merely reopening prosecution to add such claim language would not persuade the Examiner to allow the application. Indeed, the same rejections under 35 U.S.C. 103 would seemingly be maintained. *See* Examiner's Answer at pages 5-23. As such, reopening prosecution to add such language would increase (i) application pendency and (ii) labor and expense for the Applicants and the USPTO, as the Applicants would undoubtedly file a Second Appeal Brief at a later time. Thus, in order to expedite prosecution toward the most efficient resolution, the Applicants maintain the present appeal, but would be willing to add the claim language noted above (i.e., "using a processor/computer to perform the steps of") after the appeal process, if deemed necessary by the Board.

The Applicants now turn to the rejection of the pending claims under 35 U.S.C. 103, as set forth in the Examiner's Answer at pages 5-23. As noted in the Manual of Patent Examining Procedure (Revision 7, July 2008), "[t]o establish *prima facie* obviousness of a claimed

invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” *See* MPEP at 2143.03. Further, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.’ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA).” *See id.* The Applicants demonstrate that the Office Action has failed to establish a *prima facie* case of obviousness with respect to the pending claims because it fails to show or explain where the cited references teach or suggest “all the claim limitations.” *See* Appeal Brief at pages 9-17.

In general, the Examiner’s Answer makes essentially the same arguments as the Final Office Action. *Compare* Examiner’s Answer at pages 5-14 with April 15, 2008 Office Action at pages 4-13 and Examiner’s Answer at pages 14-18 with April 15, 2008 Office Action at pages 2-4. The Applicants demonstrate why these arguments in the Office Action and the Examiner’s Answer do not establish a *prima facie* case of obviousness. *See* Appeal Brief at pages 9-13.

Further, a *prima facie* case of obviousness has not been established with respect to claim 4, 12 and 27. *See* Appeal Brief at page 13.

A *prima facie* case of obviousness has also not been established with respect to claims 6, 14, 21 and 29 (*see* Appeal Brief at pages 14-15) or claims 7, 15, 22 and 30 (*see id.* at pages 15-17).

For at least the reasons discussed above and in the Appeal Brief, the Applicants respectfully submit that the pending claims are allowable in all respects. Therefore, the Board is respectfully requested to reverse the rejections of pending claims 1-31.

While no fee is believed due with respect to this Reply Brief, the Commissioner is

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nevertheless authorized to charge any necessary fees, or credit overpayment to Deposit Account 07-0845.

Respectfully submitted,

Dated: December 30, 2008

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